



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/471,393	12/23/99	STENSBORG	J 0459-0386P

IM22/1219
BIRCH STEWART KOLASCH & BIRCH LLP
PO BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

JACKSON, M

ART UNIT	PAPER NUMBER
----------	--------------

1773

DATE MAILED: 12/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/471,393

Applicant(s)

STENSBORG ET AL.

Examiner

Monique R Jackson

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 8, 9.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 12 and 29 objected to because of the following informalities: On lines 9 and 6-7 respectively, the term “**being substantially conform**” is improper verb agreement. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 9 and 17 recite the broad

Art Unit: 1773

recitation 1-50 μ m, and the claim also recites 2-25, 2-20, 5-15 and 5-10 μ m which are the narrower statements of the range/limitation.

4. Claims 18, 28, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 18, 28 and 35, the phrase "such as" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Further claim 28 recites the limitation "the article forms an integrated part of a container..." It is unclear from this limitation how the article **forms** an integrated part.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-27, 29-31, and 33-34 rejected under 35 U.S.C. 102(b) as being anticipated by Miekka et al (USPN 4,913,858.) Miekka et al teach a method of embossing a coated sheet with a diffraction or holographic pattern (Abstract.) The embossing member transfers an embossment pattern by stamping the pattern into a softened coating on a sheeting substrate whereby the embossing member may be in the form of a roll, rollers, belt or platen (Col. 2, lines 58-63; Figures 6-8.) The coating is a thermosensitive material such as polyethylene, polystyrene, polyvinylchloride and styrene butadiene like thermoplastics or semicured thermosets which have discernible thermoplastic properties (Col. 2, lines 36-42.) Miekka et al teach that the invention

Art Unit: 1773

can be used for application of diffraction gratings and holographic interference patterns (Col. 3, lines 22-24.) In addition, the coating surface can be metallized (Col. 3, lines 24-25.) In a method of high-speed embossing of a thermoplastic surface coated on a heat-resistant plastic substrate such as polyethylene terephthalate coated with polyvinylchloride, the thermoplastic can have opposed surfaces of which the surface away from a film is embossed and the surface facing the film is metallized (Col. 3, lines 27-37; Col. 4, lines 3-15.) The embossed thermoplastic surface can also be directly metallized (*equivalent to a metal layer which substantially conforms to the replicated surface relief*) (Col. 4, lines 20-21.) The thermoplastic coating thickness advantageously is between about 1.5 microns and about 50 microns (Col. 4, lines 66-67.) The embossing pattern can, in parts, be filled in with coating material, such as ink or clear lacquer, in those areas where no embossed decoration is desired (Col. 6, lines 54-57.) In one procedure, solid opaque or tinted colors can be embossed directly to produce a brilliant diffraction pattern and to give the luster and effect of metallization without actual metallization (Col. 8, lines 45-54.) Miekka et al teach another embodiment (Figure 10) comprising a metallic layer 13 with a clear overcoat structure formed by the heat-resistant film 110 and coating 12k whereby the coating is diffraction embossed (Col. 8, lines 54-60.) A variation of this embodiment is to have the metallic layer 13 sandwiched between the heat-resistant film 110 and the thermoplastic coating 12k (Col. 8, lines 60-63.) In addition, when the embossing pattern is in the coating, it is possible to control the pattern at will by simply overcoating in accordance with a desired pattern that has a same, or nearly the same (*equivalent to different*) refractive index as the embossed coating because the overcoated areas then are now devoid of the embossment (Col. 9, lines 3-9.) Miekka et al also teach that there are widespread applications for embossed plastic films with

Art Unit: 1773

holographic patterns such as application where security sensitive items such as holographic labels are used (Col. 1, lines 29-34.)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28, 32 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Miekka et al as applied to Claims 1-27, 29-31, and 33-34 above and in further view of the admitted prior art. The teachings of Miekka et al are discussed above. Miekka et al do not specifically teach that the metal layer comprises aluminum, silver, gold, titanium dioxide or zirconium dioxide and that the patterned film or label is part of a container. However, the use of aluminum is well known to those skilled in the art as a preferred metal in metallization process and in the production of embossing holograms as evidenced by the admitted prior art. Further, it is well known in the art that hologram labels or hot embossing of holographic foils are used for decoration on printed material, in particular packaging, or to protect printed materials and other products against tampering and counterfeiting. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize aluminum or other appropriate metal material in the production of the embossed plastic films with holographic patterns useful in application where security sensitive items such as holographic labels as taught by Miekka et al and to utilize the holographic label on packaging or containers as taught by the admitted prior art to provide a tamperproof decoration to the container.

Art Unit: 1773

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 703-308-0428.

The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5436 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



mrj
December 15, 2000



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700